

REMARKS

Claims 1-36 are pending. By this Amendment, claims 1, 9, 10, 17, 22, 26 and 31 are amended and new claims 35 and 36 are added. The amendment to claims 1, 17 and 26 are supported by the specification at, for example, pages 25-26. New claims 35 and 36 are supported by the specification at, for example, page 17, lines 11-24. No new matter is introduced by the present Amendment. Claims 1-34 currently stand as rejected.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 9, 10, 22 and 31 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner asserted that claims 9, 10, 22 and 31 are indefinite because, “the amount of salt is without reference as to the percentage.” Applicants have amended claims 9, 10, 22 and 31 to clarify that the inorganic ionic salts in the overcoat layer are present at various concentrations. Applicants submit that claims 9, 10, 22 and 31 are definite and respectfully request the withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,139,999 to Fuller et al. (the Fuller patent) in view of U.S. Patent 6,066,425 to Ferrar et al. (the Ferrar patent) and U.S. Patent 5,045,421 to Fuse et al. (the Fuse patent). More specifically, the Examiner asserted that the Fuller patent “teaches an overcoat layer for an imaging member used in an electrophotographic imaging process having a salt in the overcoat layer.” The Fuse patent was cited for teaching “metal complexes treated with soluble metal salts in an amount of 0.001 to 10 percent parts by weight of the binder resin,” while the Ferrar patent was cited for teaching “other electrolytes as ionic conductors.” To advance prosecution of the

claims, Applicants have amended the claims to more particularly point out their claimed invention. Applicants submit that the amended claims are not a prima facie obvious over the cited references and respectfully request reconsideration of the rejection in view of the following comments.

In order to establish prima facie obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2142. The Fuller patent relates to an electrophotographic imaging member having an overcoat layer comprising charge injection particles. The Fuller patent discloses that the charge injection particles can be organic particles such as carbon black and metal oxides such as iron oxide and titanium oxide. See Fuller patent at column 20, lines 59-67. Additionally, the Fuller patent also discloses that “other metals, their oxides, sulfides, halides and other salt forms” can be used as the charge injection particles. However, the Fuller patent does not disclose or suggest dissolving an inorganic ionic salt to facilitate formation of an overcoat layer. Rather, the Fuller patent discloses adding charge injection **particles** such as Black Pearls carbon or Steel Shot particles into the overcoat layer. See Fuller patent at Examples II-V.

The Fuse patent does not teach or suggest the incorporation of inorganic metal salts into an organophotoreceptor. Therefore, the Fuse patent clearly does not make up for the deficiencies of the Fuller patent.

With respect to the Ferrar patent, this patent explicitly teaches the use of silsequioxane polymer overcoat with metal salts that have specific interactions with the silsequioxane compositions. Thus, the Ferrar patent teaches away from the use with other polymers. Applicants claims explicitly exclude silsequioxane polymers within the overcoat layer. Therefore, the Ferrar patent does not make up for the deficiencies of the Fuller patent and the Fuse patent.

In contrast, Applicants' invention, as claimed in independent claims 1, 17 and 26 relates to an organophotoreceptor comprising an overcoat layer comprising a first binder and at least an inorganic ionic salt, wherein the inorganic ionic salt is dissolved during its incorporation into the overcoat layer. Since neither the Fuller patent, the Fuse patent nor the Ferrar patent disclose or suggest this feature of Applicants' claimed invention, the Fuller patent, the Fuse patent and the Ferrar patent, either alone or in combination, render Applicants' invention, as claimed in independent claims 1, 17 and 26, prima facie obvious.

Since the combined teachings of the Fuller patent, the Fuse patent and the Ferrar patent do not render Applicants' claimed invention prima facie obvious, Applicants respectfully request the withdrawal of the rejection of claims 1-34 as being unpatentable over the Fuller patent in view of the Ferrar patent and the Fuse patent.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Brian L. Jarrells
Registration No. 53,067

Customer No. 24113
Patterson, Thuent, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 252-1535